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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,608	11/30/2001	Michael Neal	DEM1P008	1143
36088	7590	12/27/2007	EXAMINER	
KANG LIM 3494 CAMINO TASSAJARA ROAD #436 DANVILLE, CA 94306			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/006,608	NEAL ET AL.
	Examiner Calvin L. Hewitt II	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 October 2007.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3-7,9-14 and 16-28 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,3-7,9-14 and 16-28 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 11-7-07

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

***Status of Claims***

1. Claims 1, 3-7, 9-14 and 16-28 have been examined.

***Response to Amendments/Arguments***

2. Claim 1 has been amended to include language describing "objects" that perform previously claimed functions. However, as the functions haven't changed the prior art continues to read on the claimed apparatus. In addition, it has been held that data stored in computer memory that is not functionally related to the memory on which it is stored will not distinguish a claimed computer from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II). Hence, as the database, modeling engine, subset generator, optimizer, interface and computer readable code (claim 26) are not structural aspects of the claimed apparatus, they cannot be relied upon to limit its scope. Claim 1 also currently recites "... wherein the price establishes the amount of money consumers pay for each product of the subset of product". However, a "wherein" or "whereby" clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission* 26, USPQ2d 1010 (Fed. Cir. 1993);

*Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001) therefore, as describing how the price is interpreted or is intended to be used (i.e. establishes the amount of money consumers pay) is neither a structural limitation nor a method step, it does not differentiate the claims from the prior art.

Claims 1, 3-13 and 26 continue to recite functional language (e.g. claim 1 recites “configured to”). And while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)), therefore how a device’s component is “configured” will not differentiate a claimed device from the prior art. Claim 28 also recites functional or intended use language (“wherein the largest impact...”).

Claims 26 and 27 continue to recite subject matter that may or may not occur. For example, there are no guarantees that stores have closed, records are missing or that products have had a change in information state, hence these features cannot distinguish the claims from the prior art (MPEP, 2106, II, C; *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991)). In addition, removing erroneous data from a database is old and well known, and would have been obvious to one of ordinary skill in order prevent inaccurate analysis using data from said database.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 3-7, 9-14 and 16-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is rejected, as given its broadest reasonable interpretation, it reads on storing non-functional descriptive material such as a program listing or pseudo code on a floppy or optical disk (i.e. computer readable media comprising...") (MPEP 2106.01). Claim 23 is also rejected as it recites similar language.

Claims 3-7, 9-13, 26 and 28 are also rejected as each depends from claim 1.

Claims 14, 21, 23 and 24 are also rejected as each is directed to an algorithm. For example, claims 14 and 23 are directed to "optimizing prices" while "holding" initial prices constant. This merely describes a step in a calculation. Therefore, as the claimed algorithm has not been used to produce a useful, concrete and tangible result (*AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998)) it is non-statutory. Claim

21, on the other hand recites, "setting prices". However, it is unclear whether this is performed as part of the calculation (e.g. a reiterative process, refining the model, testing the hypothesis) or is a price database updated and these new prices are acted upon to produce a useful concrete and tangible result. Claim 24 merely describes using a server to perform a calculation.

Claims 16-20 and 25-28 are also rejected as each depends from claim 14.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 3-7, 9-13, 26, 27 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is directed to an apparatus. However, claim 1 lacks "structure". Therefore, the scope of Applicant's claimed apparatus is unclear to one of ordinary skill (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

Claims 3-7, 9-13, 26 and 28 are also rejected as each depends from claim 1.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-7, 9-13, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouimet et al., U.S. Patent No. 6,094,641.

As per claims 1, 3-7, 9-13, 26 and 28, Ouimet et al. teach an apparatus comprising a computer readable media that can be used for calculating a preferred set of prices for a plurality products or a subset of said plurality (figure 2).

9. Claims 14 and 16-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouimet et al., U.S. Patent No. 6,094,641 in view of Hartman et al., U.S. Patent No. 5,987,425 and Delurgio et al., U.S. Patent No. 6,553,352.

As per claims 14 and 16-27, Ouimet et al. teach a computer implemented method for computing a preferred set of prices comprising the storing of initial prices of a plurality of products (column 3, lines 1-13), creating a demand model for generating said prices (figures 3-4B; column 3, lines 1-13), displaying optimized prices and setting store prices according to the displayed optimized price (column 1, lines 65-67; column 2, lines 12-17). Ouimet et al. also teach that an advantage of their system is that any demand model can be used (column 1, lines 59-62) hence, it would have been to one of ordinary skill to use a model derived from Bayesian statistics. Ouimet et al. do not explicitly recite dividing products into subsets. Hartman et al. teach deriving optimal prices for a plurality of products by dividing subsets according to department and price sensitivity

(abstract; figure 5; column/line 2/57-3/49; column/line 4/35-5/25). Regarding, the selection of a subset of products, Hartman et al. teach product subsets being determined by "experienced retailers" who have a "good feel for the price sensitivity of items" in a product line ('425, column 5, lines 48-64). It has been held that in order for a new combination of old elements to be patentable, the elements must cooperate in such manner as to produce a new, unobvious, and unexpected result (*In re Venner*, 120 USPQ 192 (CCPA 1958); *In re Smith*, 73 USPQ 394). It has also been held that it is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result (*In re Venner*, 120 USPQ 192 (CCPA 1958); *In re Rundell*, 9 USPQ 220). Therefore, it would have been obvious to one of ordinary skill to automate the subset selection process of Hartman et al. using a well known computer algorithm such as integer programming (IP) (Note it is inherent to the solution of an IP problem to "relax" the integer constraint in order to convert the IP problem to a more solvable LP or linear programming problem). However, neither Ouimet et al. nor Hartman et al. explicitly recite sending sales data to a server. Delurgio et al. teach sending product sales data to a server in order to receive optimized prices for said products or a subset of said products (abstract; figures 2, 11 and 12; column 7, lines 14-60). Ouimet et al. does not specifically recite demand models based on Bayesian statistics. On the other

hand, Ouimet et al. teach that an advantage of their system is that any demand model can be used (column 1, lines 59-62). Delurgio et al. also teach demand models derived using Bayesian statistics (column 8, lines 10-25). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Ouimet et al., Hartman et al. and Delurgio et al. in order to provide a grocery chain (e.g. Giant, Safeway) a method for managing prices at multiple stores ('352, column 7, lines 14-43) and better optimize prices by grouping products according to price sensitivity ('425, column/line 2/55-3/26).

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).  
  
Calvin Loyd Hewitt II  
Primary Examiner

December 13, 2007